



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,692	10/31/2001	Arlene Weisenberg	4004	4674
7590 03/31/2004				
Joseph A. Yanny Yanny & Smith 1925 Century Park East, Suite 1260 Los Angeles, CA 90067		EXAMINER PASCUA, JES F		
		ART UNIT 3727 PAPER NUMBER		

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED  
APR 09 2004  
TECHNOLOGY CENTER R3700

<b>Office Action Summary</b>	Application No. 10/002,692	Applicant(s) WEISENBERG ET AL.	
	Examiner Jes F. Pascua	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. Figures 1a, 1b, 2, 3a, 3b and 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8-10, 18 and 19 and rejected under 35 U.S.C. 102(b) as being clearly anticipated by Eichenlaub.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 10-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanke.

Blanke discloses the claimed invention except it is unclear if the portion of the envelope with holes formed therein is comprised of first and second side panels. It would have been an obvious matter of design choice to provide the envelope of Blanke with first and second side panels, since applicant has not disclosed that first and second side panels solves any stated problem or is for any particular purpose and it appears that the Blanke invention would perform equally well with first and second side panels.

Furthermore, Blanke discloses the claimed invention except for the interior surface of the closure panel carrying an adhesive strip of self-adhesive material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the interior surface of the Blanke closure panel with an adhesive strip of self-adhesive material since it was known in the art of envelopes an adhesive strip of self-adhesive material on the interior surface of a closure panel permits the envelope to be sealed before delivery.

6. Claims 1, 8-11 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacey.

Lacey discloses the claimed invention except for the interior surface of the closure panel carrying an adhesive strip of self-adhesive material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the interior surface of the Lacey closure panel with an adhesive strip of self-

Art Unit: 3727


adhesive material since it was known in the art of envelopes an adhesive strip of self-adhesive material on the interior surface of a closure panel permits the envelope to be sealed before delivery.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

  
Jes F. Pascua  
Primary Examiner  
Art Unit 3727

JFP

**Notice of References Cited**

Application/Control No.

10/002,692

Applicant(s)/Patent Under  
Reexamination  
WEISENBERG ET AL.

Examiner

Jes F. Pascua

Art Unit

3727

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-204,256	05-1878	Schade & Lockwood	229/71
	B	US-2,356,078	08-1944	EDWIN MYERS JAMES	118/500
	C	US-2,482,080	09-1949	LACEY ROBERT T	229/308
	D	US-2,949,223	08-1960	EICHENLAUB GEORGE E	229/309
	E	US-5,092,513 A	03-1992	Arbonies, Martin S.	229/68.1
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	GB 20,342	03-1892	Great Britain	Blanke	229/71
	O					
	P					
	Q					
	R					
	S					
	T					

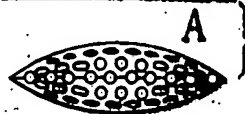
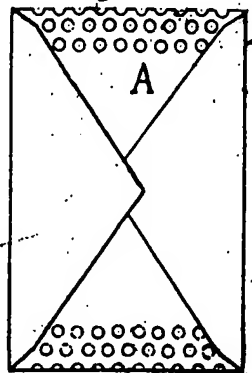
**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

ser. 64,677  
Swd. 3673

Fig. 1



2 2 9

Fig. 2

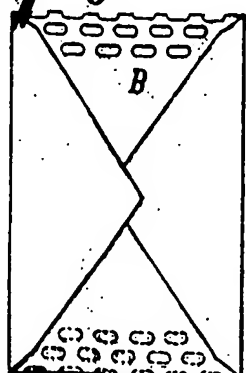


Fig. 5

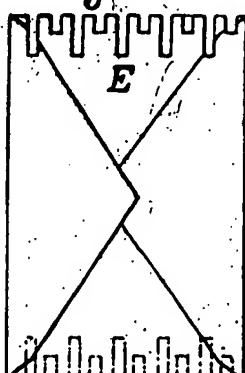


Fig. 3

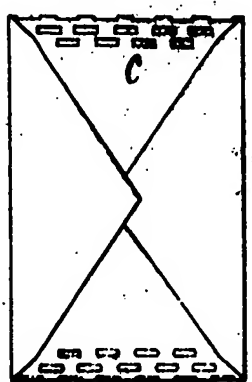


Fig. 4

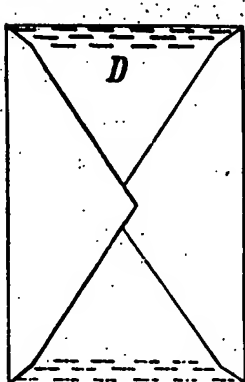
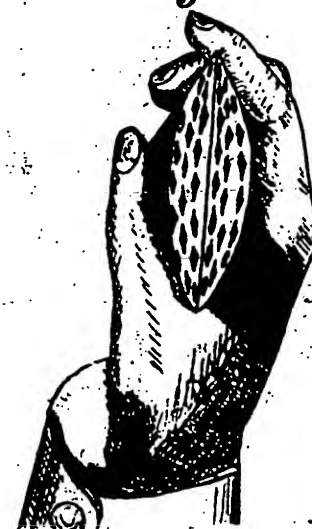


Fig. 6



[This Drawing is a reproduction of the Original on a reduced scale]

MANUFACTURES

N<sup>o</sup> 20,312



A.D. 1891

Date of Application, 23rd Nov. 1891—Accepted, 19th Mar., 1892

COMPLETE SPECIFICATION.

Improvements in Envelopes.

I, CARL BLANKE of Barmen, Kaiserstrasse No. 3 Rhenish Prussia Germany Manufacturer do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:—

The object of my invention is to be able to enclose and secure those mailable matters that are allowed to go at a lower rate, such as business papers, printed matters and the like, in such a manner that their inspection is possible without opening the envelope or rather to enable the mailing of those matters in closed envelopes out of which they cannot be lost and into which no other smaller matters can be slipped, as in the case with the ordinary cross bands now in use at the same time my new envelope which I call, "look through envelope" has for its object, whilst it allows some inspection for the post official, to hinder the removal of the contents from it, and thus to prevent their loss and their being damaged.

The new envelope is made in various manners, some of which are shown in the annexed drawing.

- Fig. 1 shows an envelope with round looking holes,
- " 2 shows an envelope with oval transversal holes,
- " 3 shows an envelope with oblong rectangular holes,
- " 4 shows an envelope with single slots,
- " 5 shows an envelope with looking holes cut in longitudinal direction,
- " 6 shows the manner of holding the envelope for inspection.

The principle of my invention is based on the fact that any wrapper of paper or similar material, when held in the hand as shown by Fig. 6 and the edges are slightly pressed together, will spread out like a balloon but the more so, when the transverse edges are weakened by partly cutting the material through by holes of any shape or simple slots, which may be made in regular order or not, as indicated in the various figures, and when one blows through these holes. A, Fig. 1, being round holes; B, Fig. 2 showing oval holes and Fig. 3 shows an envelope with oblong rectangular holes, whereas in Fig. 4 an envelope is shown having only transverse slots D cut into it; Fig. 5 is provided with holes E, cut lengthways and across the transverse edge.

The holes may be cut at one side only or on both sides, as indicated in dotted lines in the various figures.

Now when such a "look through envelope" is held in the hand and one blows into it through the holes it spreads out and allows inspection of the interior without requiring opening.

For the sender of the letter it has the great advantage that the contents are not lost and not spoiled and for the Post Office it offers the safe conveyance and prevents loss of other pieces, post cards, for instance, which now can not any more slip between sendings of this class.

Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is:

The making of envelopes called "look through envelopes" having one or two opposite sides perforated by variously shaped holes or slots, so as to allow the

[Price 8d.]



N° 20,342.—A.D. 1891.

*Blanke's Improvements in Envelopes.*

inspection of the interior without requiring the opening of the envelope as shown and described and for the purpose set forth.

Dated this 14th day of November 1891.

KARL S. MAYER,  
Agent for C. Blanke.

London: Printed for Her Majesty's Stationery Office, by Darling & Son, Ltd. —1892.

NOTICE OF OFFICE PLAN TO CEASE SUPPLYING COPIES OF CITED U.S. PATENT  
REFERENCES WITH OFFICE ACTIONS, AND PILOT TO EVALUATE THE  
ALTERNATIVE OF PROVIDING ELECTRONIC ACCESS TO SUCH U.S. PATENT  
REFERENCES

**Summary**

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site ([www.USPTO.gov](http://www.USPTO.gov)) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

**Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References**

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

## **Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter**

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: [http://www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html).

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

### Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at [eReference@uspto.gov](mailto:eReference@uspto.gov) or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

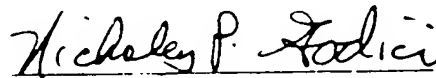
### Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

### For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

Date. 12/1/03

  
Nicholas P. Godici  
Commissioner for Patents

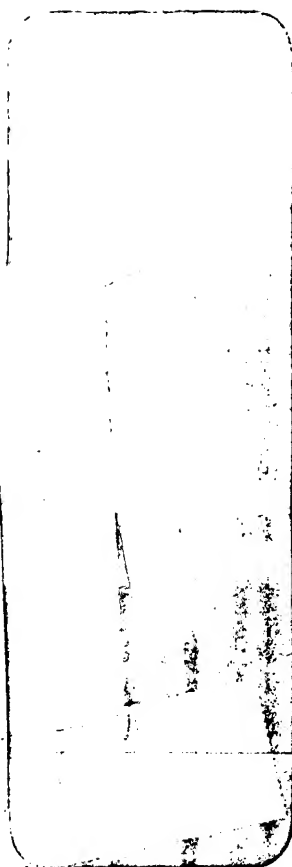
COMMISSIONER FOR PATENTS  
P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

IF UNDELIVERABLE RETURN IN TEN DAYS

OFFICIAL BUSINESS

AN EQUAL OPPORTUNITY EMPLOYER



U.S. MAIL  
H 717395